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10/814,097

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Adam Iredell Hayden

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MAGINOT, MOORE & BECK, LLP

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INDIANAPOLIS, IN 46204

EXAMINER

SCHILLINGER, ANN M

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/814,097	<b>Applicant(s)</b> HAYDEN ET AL.	
	<b>Examiner</b> ANN SCHILLINGER	<b>Art Unit</b> 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,10,13,14,31 and 38-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,10,13,14,31 and 38-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 10, 31, 38, 39, 42-45, 47-49, 51, and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Ashby et al. (US Pat. No. 5,609,644). Ashby et al. discloses the following of claim 1: a patellar prosthesis comprising: a first subcomponent (1); a boss (7) operably connected to the first subcomponent; and a second subcomponent (10) movably connected to the first subcomponent with the boss, the second subcomponent comprising, a first side, the first side having (i) a channel therein (17), (ii) a boss retaining region (18) operable to retain the boss within the channel when the boss is inserted into the channel by contacting the boss, and (iii) a boss assembly region (left side of element 17) operable to facilitate the insertion of the boss into the channel, by allowing the boss to pass through the boss assembly region for insertion of the boss into the channel (col.3, lines 35-46).

Ashby et al. discloses the following of claim 2: the patellar prosthesis of claim 1, wherein the first subcomponent comprises a base (4) and wherein the second subcomponent comprises an articulating subcomponent (11).

Ashby et al. discloses the following of claim 3: the patellar prosthesis of claim 1, wherein: the boss comprises a stem (bottom of element 7) and a head (top of element 7) having a width (Fig. 2); the channel has a first side and a second side, the second side spaced apart from

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the first side by a first distance (Fig. 6); and the boss retaining region comprises a lip (col. 3, lines 35-53), a first section having width and a second section having a width, the first section of the lip located on the first side of the channel and the second section of the lip located on the second side of the channel, the width of the head being greater than the first distance of the channel minus the width of the first section of the lip and minus the width of the second section of the lip (Fig. 6).

Ashby et al. discloses the following of claim 10: the patellar prosthesis of claim 1, further comprising: a spin stop (20) operably connected to the first subcomponent, and wherein the second subcomponent further comprises: a spin stop receiving chamber (19), the spin stop receiving chamber configured to receive the spin stop when the second subcomponent, boss and first subcomponent are assembled, such that the spin stop is movable within the spin stop receiving chamber (col. 4, lines 7-21)

Ashby et al. discloses the following of claim 31: a patellar replacement component base comprising: a generally planar bone contacting surface (4) lying in a first plane; a dome shaped contact surface (2) for contacting a patellar articulating component and located generally opposite the bone contacting surface; and a boss (7) having a stem (bottom of element 7) extending from the dome shaped articulating component contact surface along an axis, the axis of the stem intersecting the bone contacting surface plane at an angle of other than 90 degrees (Fig. 1-3).

Ashby et al. discloses the following of claim 38: the patellar replacement component base of claim 31, further comprising: a spin stop (20) extending from the dome shaped contact

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surface along an axis, the axis of the spin stop intersecting the bone contacting surface plane at an angle of other than 90 degrees (Fig. 1).

Ashby et al. discloses the following of claim 39: the patellar replacement component base of claim 38, wherein: the boss includes a head portion (top of element 7) extending outwardly from the stem portion, the head portion extending over a portion of the contact surface; and the spin stop is cylindrically shaped (Fig. 2).

Ashby et al. discloses the following of claim 42: a patellar prosthesis comprising: a first subcomponent (1); a boss (7) operably connected to the first subcomponent; and a second subcomponent (10) movably connected to the first subcomponent with the boss (col. 3, lines 35-53), the second subcomponent comprising, a first side, the first side having (i) a channel therein (17), (ii) a boss retaining region (18) having a first configuration operable to retain the boss within the channel when the boss is inserted into the channel by contacting the boss, and (iii) a boss assembly region (left side of element 17) having a second configuration operable to facilitate the insertion of the boss into the channel, the first configuration and the second configuration being different,.

Ashby et al. discloses the following of claim 43: the patellar prosthesis of claim 42, wherein the first subcomponent comprises a base (4) and wherein the second subcomponent comprises an articulating subcomponent (11).

Ashby et al. discloses the following of claim 44: the patellar prosthesis of claim 42, wherein: the boss comprises a stem (bottom of element 7) and a head (top of element 7) having a width; the channel has a first side and a second side, the second side spaced apart from the first side by a first distance (Fig. 6); and the boss retaining region comprises a lip (col. 3, lines 35-53),

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a first section having width and a second section having a width, the first section of the lip located on the first side of the channel and the second section of the lip located on the second side of the channel, the width of the head being greater than the first distance of the channel minus the width of the first section of the lip and minus the width of the second section of the lip (Fig. 6).

Ashby et al. discloses the following of claim 45: the patellar prosthesis of claim 42, further comprising: a spin stop (20) operably connected to the first subcomponent, and wherein the second subcomponent further comprises: a spin stop receiving chamber (19), the spin stop receiving chamber configured to receive the spin stop when the second subcomponent, boss and first subcomponent are assembled, such that the spin stop is movable within the spin stop receiving chamber (col. 4, lines 7-21).

Ashby et al. discloses the following of claim 47: the patellar prosthesis of claim 46, further comprising: a spin stop (20) operably connected to the first subcomponent, and wherein the second subcomponent further comprises: a spin stop receiving chamber (19) with a loading region (left side of element 19), the loading region of the spin stop chamber configured such that when the boss is being inserted into the channel through the boss assembly region, the spin stop is inserted into the spin stop chamber loading region (Fig. 8).

Ashby et al. discloses the following of claim 48: a patellar replacement component base comprising: a body (1) defining a generally planar bone contacting surface (4) lying in a first plane, a dome shaped articulating component contact surface (2) generally opposite the bone contacting surface; a stem (bottom of element 7) extending outwardly from the dome shaped articulating component contact surface of said body along a line, the line of the stem intersecting

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the bone contacting surface plane at an angle of other than 90 degrees; and a head (top of element 7) extending from said stem.

Ashby et al. discloses the claim 49 as shown in Figure 2.

Ashby et al. discloses the following of claim 51: the patellar replacement component base comprising: a integral body (1) defining generally planar bone contacting surface (4) lying in a first plane, a dome shaped contact surface (2) generally opposite the bone contacting surface; and a stem (bottom of element 7) extending outwardly from the dome shaped contact surface of said body in a direction away from the generally planar bone contacting surface along an axis, the axis of the stem intersecting the bone contacting surface plane at an angle of other than 90 degrees, the stem being integral with said body (Fig. 2).

Ashby et al. discloses the following of claim 52: the patellar replacement component base of claim 51, further comprising a head (top of element 7) extending from said stem.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 14, 40, 41, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ashby et al. Ashby et al. discloses the claimed invention except for the boss assembly region being offset from the channel; the dome contact surface being spherical; and the boss and spin stop being on opposite sides of the apex. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the boss assembly region

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being offset from the channel; the dome contact surface being spherical; and the boss and spin stop being on opposite sides of the apex, since such modifications would have involved a mere change in the shape and/or size of these components. A change in shape is generally recognized as being within the level of ordinary skill in the art.

Regarding claim 14, Ashby et al. teaches the following: the patellar prosthesis of claim 13, further comprising: a spin stop (20) operably connected to the first subcomponent, and wherein the second subcomponent further comprises: a spin stop receiving chamber (19) with a loading region, the loading region of the spin stop chamber configured such that when the boss is being inserted into the channel through the boss assembly region, the spin stop is inserted into the spin stop chamber loading region (left side of element 19; Fig. 8).

Claims 50 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ashby et al. in view of Whiteside et al. (US Pat. No. 5,019,104). Ashby et al. discloses the invention substantially as claimed, however, Ashby et al. does not teach the implant's body, head, and stem being made of a polymer. Whiteside et al. teaches a patellar implant where the components may be made of a polymer in col. 1, line 45 through col. 2, line 6, 25-37 for the purpose of utilizing the material's biocompatibility. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the parts of the Ashby et al. reference from polymers in order to utilize the material's biocompatibility.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 14, 31, 38, 42, 47, 48, and 51 have been fully considered but they are not persuasive. The Applicant contends that the Ashby et al. reference does not disclose a boss assembly region. The examiner respectfully disagrees. The



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boss assembly region is described as a region operable to facilitate the insertion of the boss into the channel. The left region/side of element 17 is an area/opening connected to the slot, where the boss may be inserted into channel 17, thus meeting the claims' limitations. In claim 14, the spin stop receiving chamber is being interpreted as a chamber operable to facilitate the insertion of the boss into the channel. The left region/side of element 19 is an opening where the spin stop may be inserted into channel 19.

The Applicant contends that Ashby et al. does not disclose a generally planar bone contacting surface with the stem intersecting at angle other than 90 degrees. The examiner respectfully disagrees. The examiner is interpreting "generally planar" to mean that the surface *generally* lies in one plane. Figure 6 of the Ashby et al. reference shows that the central section of the lower surface, element 4, has a generally planar configuration. The peripheral sections of element 4 are curved downward, and therefore, the stems (5) do not intersect the bone contacting surface at 90 degrees (please see Figure 6). Likewise, regarding claim 38, Figure 2 of the Ashby et al. reference shows that the top of element 1 is curved, and therefore, the spin stop will not intersect surface (2) at 90 degrees.

Applicant's arguments with respect to claims 13, 40, and 46 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANN SCHILLINGER whose telephone number is (571)272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on (571) 272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. S./

Examiner, Art Unit 3774

/DAVID ISABELLA/

Supervisory Patent Examiner, Art Unit 3774